

Atty Dkt. No.: CLON-028
USSN: 09/976,673

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-12 and 18-24 the only claims pending and currently under examination in this application.

Formal Matters

Claims 1-12, 18-24 are pending after entry of the amendments set forth herein.

Claims 1-12 and 18-24 were examined. Claims 1-12 and 18-24 were rejected. No claims were allowed.

Claims 1, 5, 7-10, 18-24 have been amended. Support for the amendments can be found in the claims as originally filed and throughout the specification at, for example: page 8, lines 19-31; and page 17, lines 28-32.

As the above amendments introduce no new matter to the application, their entry is respectfully requested.

Withdrawal of Objections and Rejections

The Applicants express gratitude in the Examiner's indication that objections and rejections not repeated from the Office Action dated December 27, 2004, have been withdrawn.

Rejection under 35 U.S.C. § 112, first paragraph (Enablement)

The Office Action maintains the rejection of Claim 8, under 35 U.S.C. § 112, first ¶ for an asserted lack of enablement, based on an asserted insufficient description of the term "stringent" in the specification. In view of the amendments to the claim, this rejection is respectfully traversed.

In the spirit of expediting prosecution and without conceding as to the correctness of the rejection, claim 8 has been amended to recite " wherein said stringent conditions are at least as stringent as hybridization at 42°C in a solution comprising 50% formamide, 5 × SSC, 50 mM sodium phosphate, 5 × Denhardt's

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solution, and 10% dextran sulfate". Support for the amendment can be found in the specification at, for example, page 8, lines 19-31.

Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. § 112, first paragraph (Written Description)

The Office Action has maintained the rejection of Claims 1-2, 7-12 and 18-19 under 35 U.S.C. § 112, first paragraph, for allegedly lacking written description. IN addition, the rejection has been amended to include Claims 20-24. In view of the amendments to the claims, this rejection is respectfully traversed.

In maintaining the rejection, the Examiner has asserted on that "the claimed nucleic acid is only defined by a function (encoding a protein) not a structure" (Office Action, December 27, 2004, page 4). In addition, the Examiner has also stated that "the claims encompass a genus of mutants not adequately described in the instant specification" (Office Action, December 27, 2004, page 5).

Without conceding as to the correctness of the rejection, Claim 1 has been amended to recite "wherein said nucleic acid has a sequence similarity of at least about 75% with a nucleotide sequence of SEQ ID NO: 11" thereby proving the structure for the claimed nucleic acid. In addition, with respect to Claims 7-12 and 18-25, the claims have been amended to remove the objectionable language.

Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection Under Obvious-Type Double Patenting

Application No. 10/006,922

The Office Action has maintained the provisional rejection of Claims 1-2, 7-12 and 18-19 under the judicially created doctrine of obviousness-type double patenting over Claims 1-5, 8-10, 12-15, and 22-23 of co-pending Application No. 10/006,922. In

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addition, the Office Action has amended the rejection to include Claims 20-24. This rejection is respectfully traversed.

As noted above, Claim 1 has been amended to recite "wherein said nucleic acid has a sequence similarity of at least about 75% with a nucleotide sequence of SEQ ID NO: 11". In contrast, the co-pending '922 application does not disclose the nucleic acid sequence of SEQ ID NO:11.

Therefore, the Applicants respectfully request that this rejection be withdrawn.

Application No. 10/081,864

The Office Action has maintained the provisional rejection of claims 1-2, 7-12 and 18-19 under the judicially created doctrine of obviousness-type double patenting over Claims 1-3, 5-9, and 15-16 of co-pending Application No. 10/081,864. In addition, the Office Action has amended to rejection to include claims 20-24. This rejection is respectfully traversed.

As noted above, Claim 1 has been amended to recite "wherein said nucleic acid has a sequence similarity of at least about 75% with a nucleotide sequence of SEQ ID NO: 11". In contrast, the co-pending '864 application does not disclose the nucleic acid sequence of SEQ ID NO:11.

Therefore, the Applicants respectfully request that this rejection be withdrawn.

Application No. 10/155,809

The Office Action maintains the provisional rejection of claims 1-12 and 18-19 under the judicially created doctrine of obviousness-type double patenting over claims 1-16, 21 and 43 of co-pending Application No. 10/155,809. In addition, the Office Action has amended to rejection to include claims 20-24. This rejection is respectfully traversed.

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As noted above, Claim 1 has been amended to recite **"wherein said nucleic acid has a sequence similarity of at least about 75% with a nucleotide sequence of SEQ ID NO: 11"**. In contrast, the co-pending '809 application does not disclose the nucleic acid sequence of SEQ ID NO:11.

Therefore, the Applicants respectfully request that this rejection be withdrawn.

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CONCLUSION

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,

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Date: August 25, 2005

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